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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,499	11/10/1999	TSUMORU MATSUURA	44376-028	8064

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MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/02/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,499

Applicant(s)

Matsuura et al

Examiner

Mark Wallerson

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 12-15, and 17-20 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 10, and 16 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-20 are pending.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The references listed in the Information Disclosure Statement dated 11/10/99 have been considered by the Examiner and is attached to this Office Action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 3, 4, 5, 9, 12, 13, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka (U. S. 5,126,786).

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With respect to claims 1, 2, 3, and 9, Tanaka discloses an image forming apparatus comprising a plurality of trays (7, 8, and 9) for receiving discharged sheets bearing an image; means for setting the form of output with respect to at least one of the trays (column 5, lines 47-59 and column 16, lines 31-43); and an image forming unit (1) for forming an image on the sheets in the form of output (duplex) set by the setting means when the output tray is selected (column 4, lines 56-61 and column 9, lines 60-68).

With regard to claims 4 and 5, Tanaka discloses forming images on the obverse and reverse sides of a sheet (duplex) (column 9, lines 60-68).

With respect to claims 12, 13, 14, and 15, Tanaka discloses an image forming apparatus (figure 2) comprising a plurality of trays for receiving discharged sheets bearing a formed image (7, 8, and 9); means for setting the size of discharged sheets with respect to the trays (column 16, lines 45-53), and supplying sheets of set size to the discharge tray (column 16, lines 45-59).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17, 18, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Taneda et al (Taneda) (U. S. 5,236,185).

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With respect to claims 17 and 20, Taneda discloses an image forming apparatus comprising a plurality of trays (6) for receiving discharged sheets bearing an image; means for setting a post-handling of sheets with respect to the trays (column 6, lines 7-19), and a sheet processing unit for performing the post handling of sheets by the selected tray (column 6, lines 7-32).

With regard to claims 18 and 19, Taneda discloses that the post handling is a process for stapling and punching (column 6, lines 3-6).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Matsui et al (Matsui) (U. S. 5,921,537).

With respect to claim 6, Tanaka differs from claim 6 in that he does not clearly disclose the plural trays are allocated to a specific user. Matsui discloses a printing system whereby bins are allotted to various operators (column 12, lines 57-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tanaka wherein the plural trays are allocated to a specific user. It would have been obvious to one of ordinary skill in

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the art at the time of the invention to have modified Tanaka by the teaching of Matsui in order to simplify the discharge process.

Allowable Subject Matter

10. Claim 11 is allowed.

11. Claims 7, 8, 10 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

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Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)



MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON